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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,776	10/23/2000	Joseph Sforzo		8512

7590 10/27/2005
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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/694,776	Applicant(s) SFORZO, JOSEPH	
	Examiner JAGDISH PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17,20-35 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17,20-35 and 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

4

DETAILED ACTION

1. This communication is in response to amendment filed 7/25/05.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/25/05 has been entered.

Response to Amendment

3. Claims 38, 40 have been amended. Claims 2-17, 20-35, 38-47 are currently pending.

Response to Arguments

4. Applicant's arguments, see pp. 11-27 of response, filed 7/25/05, with respect to rejection of the pending claims have been fully considered and are persuasive. The rejection of claims 2-17, 20-35, 38-47 under 35 USC 103(a) have been withdrawn. Upon further examination of the pending claims the examiner has identified significant deficiencies in the pending claims not addressed in the prior office action(s). Please refer to the following analysis of the claims under 35 U.S.C. 112, second paragraph.

Art Unit: 3624

5. Claims 2-17, 20-35 and 38-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 Lack of antecedent Basis

Claim 38. Step b) “an applicant” should read “the applicant” or “said applicant”.

Step d) “an approved bond” does not relate to “the bond” recited in step c).

5.2 Essential Steps Omitted

Method claims 38-40, 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP Section 2172.01. The omitted steps are discussed in the following paragraphs.

Claim 38 (and dependent claims 2-17) Note that the receiving step c) only recites receiving a decision which, may be an approval or denial. Therefore, there is no antecedent basis for the term “an approved bond”.

Step d) “to be submitted to said third party” is intended use of the “authorization code” since, the claim fails to positively recite that the authorization code is actually submitted to the third party. In view of this deficiency, step e) “permitting said third party to use said authorization code” cannot be performed. In other words, the bond cannot be accessed by the third party unless the latter receives the authorization code.

The claim is also rendered indefinite and unclear because there is recitation that the agent (via an agent computer), the surety (server or computer) and the third party (computer) are connected via the computer network using their respective computers and that the approval of the surety bond results in posting of the approved surety bond on the surety computer and that the approved surety bond has an associated authorization code (which is provided to the applicant as recited), and finally, the third party is provided is provided access to the surety bond via the computer network using the authorization code.

The claim is also rendered indefinite and unclear because the limitation f) issuing said surety bond..to said third party is unclear. The act of issuing a document is performed between two

Art Unit: 3624

parties. In the instant case, it is unclear as to the source of the surety bond issued to the third party because the surety bond is not stored anywhere which may be accessible to the third party.

Claim 39: The claim is rendered indefinite and unclear because there is no recitation that the agent (or some other entity), and the surety (server or computer) are connected via the computer network using their respective computers in order to facilitate step b). The role of the computer network in context of claim 39 is not clear since there is no recitation of the parties (surety, contractor) having computers connected to the computer network.

Step b) recites, "such other information said surety may require", which renders the claim indefinite and unclear since precise scope of the claim cannot be ascertained.

The claim is also rendered indefinite and unclear because the phrase "the type of bond desired by said contractor" is vague and unclear. There is no indication or standard provided to select a particular type of bond "desired" by a contractor.

Furthermore, the claim fails to recite relationship of step c) to any other step because nowhere in the claim is there any reference of the selected type of bond.

Steps a) through g) are recited in manner that there they do not functionally relate to each other. This "disconnect" between the process steps renders the claim as a whole indefinite or vague and unclear. See explanation provided below.

The information provided to the (selected) surety in Step b) is not used anywhere. For example, the decision of the surety is independent of the information provided (step e)).

Note also that step f) recites an authorization code for an approved bond. This contrasts with method step e) which recites "whether the bond is approved". Step f) is dependent upon the outcome of the decision.

Step g) recites "the bond issued by said surety" which lacks antecedent basis in the claim for the reasons discussed above.

Claims 40 also contains deficiencies similar to those discussed above in analysis of method claims 38 and 39.

Claim 40, additionally contains the following deficiencies.

Line 3 of claim recites "proving a computer network with identity of an applicant..said surety". This limitation renders the claim indefinite because the providing the computer network with the identity is unclear. A computer network is a conduit of transmitting information and not a computing device or a physical entity to whom information (i.e. the identity of an applicant) can be provided.

Art Unit: 3624

The limitation “selecting a surety” is unclear because there is no basis for selecting a surety. The providing step provides an identity of an applicant to a surety. The selection of a surety is independent of the surety who requests identity of the applicant, there is no process step responsive to the providing step, which plays any role in selection of a surety.

Claims 46 and 47 also contain deficiencies similar to those identified for other method claims.

5. Claims 41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are discussed below.

Claims 41 and 42 are recited as “system” for obtaining a surety bond. However, all limitations are “means for” format. A system claim must have structural cooperative relationship among the elements of the system. The claims recite various “means” which stand on their own without any relationship to others.

6. Claim 42 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a system, but the body of the claim recites the specifics of the system (means for) and the process (steps f) and g)).

7. claim 43 recites the apparatus as comprising a web server and a web browser running on a client workstation wherein the web workstation is in communication with a web server. However, the claim is silent about functionality of the web server and all limitations pertain to the workstation. The claim further recites that the work station is “being capable” of performing certain functions which renders the claim so broad that it read on any workstation since such functions can be carried out over any workstation connected to a server. This renders the claim indefinite as to the structure of the apparatus.

Additionally, the claim is indefinite for the reasons similar to those discussed in respective method claims.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 41 and 42 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

Claim 41: 35 U.S.C. §101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a system (ex. Preamble of claim 42), the body of the claim recites the specifics of the system and method (explain method limitations). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). “a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548).

9. Claims 41 and 42 are rejected under 35 USC § 101 because the claimed inventions are directed to non-statutory subject matter. Claims 41 and 42 are directed to disembodied data structure which are per se are not statutory (*In re Warmerdam*, No. 93-1294 (Fed. Cir. August 11, 1994)).

Note that functional descriptive material consists of data structure and computer programs, which impart functionality when employed as a computer component. Nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Quoting MPEP section 2106. IV. B. 1.

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk.”

The “means for” elements of the system claims are interpreted as computer codes that perform the associated functions when executed by a computer processor such data structures themselves are passive and cannot perform any function. Only when the Data structures are used or accessed in conjunction with programmed computer instructions codes to realize the underlying functionality. In the instant case, the data structure is mere arrangement of data (means) that are intended to perform various functions. The subject claims when broadly interpreted computer software programs or executable codes which are not functionally or structurally interrelated and not executed by a processor to realize any functionality. Therefore, the claims are interpreted as functional descriptive material which are not capable of producing useful, concrete and tangible result, i.e. non-statutory under 35 USC 101.

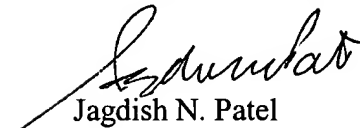
Art Unit: 3624

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

10/25/05